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No. 03-1042

Supreme Court, U.S.
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In The

Supreme Court of the United States

SENIOR TECHNOLOGIES, INC.,

Petitioner,

v.

R.F. TECHNOLOGIES, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITIONER'S REPLY TO RESPONDENT'S BRIEF IN OPPOSITION

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PARTIES TO THE PROCEEDING AND CORPORATE DISCLOSURE STATEMENT

Petitioner: Stanley Security Solutions, Inc. dba Senior Technologies (formerly Senior Technologies, Inc.)

Petitioner's Corporate Disclosure Statement:

All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:

> The Stanley Works owns all of the stock of Stanley Security Solutions, Inc. and is the only parent corporation holding 10 percent of the stock or more.

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NEW POINTS PRESENTED IN BRIEF IN OPPOSITION

The Respondent's brief in opposition rewords the two questions presented to the Court in the Petitioner's petition into two new questions with entirely different meanings. The first question presented by the Petitioner is related to the propriety of construing claim 1 to include a limitation of a "housing", not expressly in the claim, namely:

> "1. In a patent infringement action, can a patent claim that literally and unambiguously reads on an accused device be construed to include a limitation based on the patent specification?"

(Petition for Writ of Certiorari, page i)

The second question presented by the Petitioner is related to the application of the Doctrine of Equivalents to the term "housing" construed to be in claim 1, namely:

> "2. Is a limitation that was construed to be in a claim precluded from being expanded under the doctrine of equivalents because the construed limitation is described in the specification in absolute terms or because it was construed to be in the claim rather than being introduced by the patentee?"

(Petition for Writ of Certiorari, page i)

The two new or reworded questions proposed by the Respondent are matters not in question themselves but matters that beg the question. They apparently are intended to be arguments to support the Respondent's position and will be treated as such. They are:

> "1. Was it error for the CAFC to adhere to its original construction of Claim 1 following a remand from the U.S. Supreme Court on the issue of the Doctrine of Equivalents?
>
> 2. Was it error for the CAFC to decide the issue of infringement under the Doctrine of Equivalents based on the claim language?"
>
> (Brief in Opposition, page i)

The first proposed question by the Respondent begs the question as to whether the original construction of claim 1 was error itself. If it was error then failure to cure the error upon remand from the United States Supreme Court leaves the error in place as question 1 presented by the Petitioner. Actually the first question presented in the petition is principally a question related to the test for infringement and only secondarily a question of claim construction.

The error the Petitioner believes to have been made is not the straw error in claim construction first postulated and then argued by the Respondent in the Respondent's brief in opposition. The Respondent incorrectly characterizes the Petitioner's position as arguing against a supposed construction of claim 1 as requiring that the antenna and receiver be in the sensing module. The Petitioner is not arguing against that construction. Indeed, it is not even a construction but a statement made in the specification and claims and agreed upon by all parties. It was used by the CAFC as a preliminary statement of fact (Appendix A-23, second full paragraph) in applying a test for infringement that the Petitioner believes to be in error as a deviation from the long-standing test in *Graver Tank & Mfg. Co., Inc., et al. v. Linde Air Products Co.,* 339

U.S. 605, 70 S.Ct. 854, 94 L.Ed. 1097, 85 USPQ 328 (1950). The error was in reading a limitation from the specification into claim 1 even though claim 1 reads unambiguously and literally on the accused device. The fact that the sensing module includes the antenna and receiver in both the accused devices and in claim 1 supports infringement.

It supports infringement because the sensing module, when understood as including the antenna and receiver of the accused device, is adjacent to the door as required by claim 1. Because the sensing module is one unit or module containing a plurality of electrically connected components with one side, namely the antenna, next to the door as recited in claim 1 and as held to be in all of the four accused devices by the CAFC (paragraph bridging Appendix A-17 and A-18), claim 1 reads literally on the accused devices. The sensing module is adjacent to the door for the same reason that my house is adjacent to my neighbor's house, i.e. one side of my house is next to one side of my neighbor's house and the other side of my house is separated from my neighbor's house by the full length of my house.

The District Court and the CAFC apparently recognized this and did not base their decisions with respect to claim 1 on the fact the sensing module included both the antenna and the receiver. The United States District Court based its decision of noninfringement of claim 1 on the holding that the control unit of the accused devices were not part of the receiver and were in the circuit that was connected to the door switch. (Appendix A-61, paragraph 18) The CAFC, after holding that the literal infringement analysis of the District Court was clear error, based its holding of noninfringement on its holding that

the antenna and receiver needed to be in a single housing even though the single housing was not recited in claim 1.

The Respondent argues that Petitioner did not appeal the single housing rejection when it was made by the District Court but instead argued claim 6. However, claim 1 was not rejected under the single housing theory by the District Court. It could not reject claim 1 on this ground because claim 1 does not recite a housing at all. This was not an oversight. The District Court recognized that a narrower claim, claim 6, did recite a housing containing the receiver (but not the antenna) and based its decision on the single housing limitation. This claim is not before the United States Supreme Court at this time.

When the CAFC held the noninfringement analysis of the District Court to be clear error, it did not hold that there was a second noninfringement holding of the District Court on which it could rely. Instead it clearly held it was turning to an alternative ground supported by the record and did not say it was turning to another ground for holding noninfringement made by the District Court. The supporting record was the Respondent's brief and the District Court's discussion of infringement with respect to claim 6.

This petition should be granted, not only because of this case, but because the long standing test provided by *Graver, et al. (supra)* has recently been rendered less useful by reading limitations into claims. This has happened in six cases decided since 1997 as set forth on pages 14 and 15 of the petition. In this case, a "housing" was read into a claim in which it has no essential functional role even though the claim had no prior art cited against claim 1 before the United States Patent and Trademark

Office nor before the District Court. It is clearly a pioneer invention in the nursing care industry and should receive the scope of protection provided under the test for infringement in *Graver, et al. (supra)* and by the patent statutes.

The Respondent argues that the housing is necessary because the specification describes conductors connected to terminal posts that are part of the housing. The fact that an engineer or designer uses a housing in the interest of sturdiness does not make the housing essential. The housing could be disposed of altogether assuming one does not break the conductors in doing so. Terminal posts are not necessary and are only a device that makes a radio less subject to breakage. No one would fail to connect the conductors just because there was no terminal post when assembling a radio receiver. Indeed the circuit would operate even if a separate housing were used for every component shown in FIGS. 3 and 4 of the '155 patent (Appendix A-78 and A-79).

The second question or argument posed by the Respondent raises the Petitioner's issue with respect to the Doctrine of Equivalents but again only states the obvious and is immaterial. This second question or argument posed by the Respondent is:

> "2. Was it error for the CAFC to decide the issue of infringement under the Doctrine of Equivalents based on the claim language?"

(Brief in Opposition, page i)

Of course it would not have been error to decide the issue of infringement under the Doctrine of Equivalents based on claim language. However, that is not what the CAFC did here. The question before this Court is not

whether the language of a claim can be used in deciding infringement under the Doctrine of Equivalents. Obviously it can.

Instead, the issue is whether the Doctrine of Equivalents is automatically precluded as to a construed limitation in the claim. Similarly, the Respondent's argument that the Petitioner drafted the claim narrowly and must now suffer the consequences is inapplicable. The Petitioner did not draft the claim narrowly. The CAFC construed a narrow limitation from the description of the preferred embodiment to be in the claim. The "all limitations" rule does not bar the Doctrine of Equivalents in this case. That rule is satisfied when the equivalent structure corresponds to each limitation of the claim, which is true here. The "all limitations" rule has nothing to do with the number of housings of the equivalent component. There is no File Wrapper Estoppel and the CAFC did not rely on File Wrapper Estoppel on remand.

The CAFC limited claim 1 as to requiring a single housing within which lies the receiving circuit. This is the limitation the Court of Appeals for the Federal Circuit construed to be in claim 1 when it held:

> "We must, however, also determine whether the district court's conclusion of noninfringement can be affirmed on alternative grounds present in the record before us. . . .
>
> Another issue before the district court was whether the '155 patent disclosed a limitation of a single housing within which lies the receiving circuit. As a matter of law, we conclude that both claims 1 and 6 do include such a limitation."

> (Appendix A-22, last paragraph through A-23, first full paragraph)

There was no discussion of File Wrapper Estoppel in the decision from which the petition is taken. Instead, the CAFC, referring to *Scimed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 58 USPQ2d 1059 (Fed. Cir. 2001), stated:

> "Applying the well-settled rule summarized in *Scimed* to the alleged infringement of claim 1 by the CA9000 model, we explained that 'an attempt to expand the scope of claim 1 under the doctrine of equivalents to encompass the accused devices, which have antennae located outside of the receiving circuit's housing, would *eviscerate* the construed limitation that they [the antenna and the receiving circuit] be contained within the housing.'"

> (paragraph bridging Appendix A-9 and A-10)

In this case, the construed limitation would not be eviscerated but considered as to whether the accused device uses substantially the same invention to perform substantially the same function in substantially the same way to accomplish the same result. There is no reason in this record indicating that that would not be in accord with the purposes of the Doctrine of Equivalents as stated in *Graver, et al. (supra)*, which is to avoid noninfringement based on:

> "unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law.". *Graver, supra* at 607.

The logic behind the Doctrine of Equivalents applies whether the claim is construed to have the irrelevant

limitation of a housing or the applicant inserted the irrelevant limitation. The two housings of the accused units perform substantially the same function in substantially the same way to obtain the same result as the "single housing" limitation construed to be in claim 1. *Graver, supra* at 608. Thus, even if there is no literal infringement, there is infringement under the Doctrine of Equivalents.

The Court here is extending a rule against expanding a claim to cover an expressly disclaimed embodiment to a situation in which the examiner and applicant agreed to language covering the embodiment and there was no disclaimer. The invention will operate just as well with any number of housings. More troubling is the fact that the CAFC could just as easily have chosen any other component not important to the invention but advantageous to the Respondent to read into the claim and there would be no infringement even though the accused infringer copied what the examiner and patentee agreed upon as the patented invention.

Claim 1 not only does not recite "housing", it doesn't recite the sensing module and receiving means in a single housing. It does not recite anything about the location of the components of the sensing module but only what at least some of those components are.

CONCLUSION

It is the Petitioner's position that the Court of Appeals improperly construed claim 1 to include limitations not recited in it to affirm the District Court's holding of no literal infringement and then relied upon *Festo Corporation*

v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 122 S.Ct. 1831 (2002) (*Festo VIII*) and *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed Cir. 1996) to preclude infringement under the Doctrine of Equivalents.

The two questions presented by the Petitioner will settle important legal questions that affect the patent incentive system. They address an uncertainty introduced into the legal system by four recent decisions of the CAFC that render uncertain decisions made by the public about the scope of patents that were at one time certain under the test provided for many years by *Graver, et al. (supra).* A decision on the questions presented in the Petitioner's petition will increase the certainty with which such decisions can be made and the confidence in making possible investment in new product development.

Respectfully submitted,

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